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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,278	06/25/2003	John Keeney Howie	9285	4432

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EXAMINER

HENDRICKS, KEITH D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/603,278

Applicant(s)

HOWIE ET AL.

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 06, 2006 has been entered.

### *Examiner Comments on Suggested Suspension for Interference*

Applicant's comments filed January 06, 2006, have been fully considered but they are not persuasive.

At page 2 of applicant's response, applicant submits the following remarks:

The present application is related and commonly assigned to US Patent Application No. 10/606,137, filed in the name of Zyzak, et al. The Zyzak '137 application claims priority to an application filed on September 20, 2002 while the Elder application claims priority to September 19, 2002. Generally speaking, the subject matter of the present case, the Zyzak '137 application and the Elder application [US Patent App. No. 2004/0058054] relates to the reduction of acrylamide in food products.

On August 22 of this year [2005], a Suggestion of Interference was filed in the Zyzak '137 application over the Elder application. Moreover, the US PTO Private Pair suggests that the prosecution in the Elder application has been suspended, perhaps due to an interference with another application dealing with the reduction of acrylamide in food products.

Regardless, the present application is rejected over the Elder application and commonly owned with the Zyzak '137 application. It is respectfully requested that prosecution in the present application be suspended pending the outcome of the Suggestion of Interference between the Elder and Zyzak '137 application.

At this time, the Office will not comment on the status of another application which is not co-owned and related to the current application, and/or possesses a common inventor. Regardless of any potential interference which may or may not eventually occur in any given application, the applicant must overcome all applicable and appropriate rejections, i.e. 35 U.S.C. 112 and prior art rejections, before the

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current claims may be considered allowable and in condition for further action, be it allowance or interference.

Given applicant's proposed scenario and in response to applicant's comments, applicant is also referred to MPEP section 2303, which states that "an interference should rarely be suggested until examination is completed on all other issues. Each pending claim must be allowed, finally rejected, or canceled." MPEP section 2302 reads:

Practice 2. Party not in condition for allowance.

When:

(A) a first application and a second application claim the same patentable invention;  
and

(B) a first application is in condition for allowance; and

(C) the second application is not in condition for allowance,

then generally a notice of allowance should be entered in the first application and it should become a patent.

Without suspending action in the first application and after consultation consistent with Practice 1 above, the examiner may wish to give the second applicant a very brief period of time within which to put the second application in condition for allowance, e.g., by canceling rejected claims thereby leaving only allowable claims which interfere with the claims of the first application.

When examination of the second application is complete, an application versus patent interference may be appropriate.

Practice 3. Both in condition for allowance; earliest effective filing dates within six months.

When two applications are in condition for allowance and the earliest effective filing dates of the applications are within six months of each other, an application versus application interference may be suggested, provided the applicant with the later filing date makes the showing required by 37 CFR 41.202(d). Note that if the earliest filed application is available as a reference (for example, as a published application under 35 U.S.C.

102(e)) against the other application, then a rejection should be made against the other application. Ideally, the rejection would be made early in the prosecution, but if it is not and as a result the junior application is not in condition for allowance, then the senior application should be issued. In light of patent term adjustments it is no longer appropriate to suspend an application on the chance that an interference might ultimately result.

At the time of this Office action, the current application is not in condition for allowance, as all issues have not been resolved.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-13 and 17-18 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “reduced... when compared to conventionally processed cocoa beans”, is a relative term which renders the claims indefinite. The terms “reduced”, as well as “conventionally processed”, are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Applicant's arguments filed January 06, 2006, have been fully considered but they are not persuasive.

At page 3 of the response, applicant asserts that the specification does indeed “provide the proper definition and understanding of the term ‘reduced’ as it relates to both asparagine-reduction and acrylamide-reduction.” Applicant provides a footnote which quotes page 3 of the specification. Part of this quote states that “acrylamide *formation* in roasted cocoa beans can be *reduced* by...” (emphasis added). The examiner agrees with this statement as it relates to a positive *action* (i.e. formation), not a resultant product. This is reflected in the fact that the method claims have not been rejected. See also the related statements set forth previously on the record and below.

Applicant argues that one skilled in the art would understand the definition of the term “reduced.” Again, the Office does not disagree with this statement. However, it is important to note that the term “reduced” is a relative term, which requires a former initial state to which it is compared. Again, this is the result of an *action*, not simply a state of being. As previously stated on the record, the term “reduced” implies both a current condition and a previous condition, as well as a change from the previous to the current state. A product, as it stands in its current state, cannot simply be “reduced”, without reference to a standard or to the previous condition. Further, as an example, if two distinct roasted cocoa beans each contain 350 ppb of acrylamide, where one naturally contained said amount and one had been processed according to the invention, given this data alone, it would be impossible for one skilled in the art to determine which one had been “reduced” from a previously higher amount, and which one was naturally at this level. Still further, it is noted that a roasted cocoa bean cannot have a “reduced amount of

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acrylamide”, if it never had a previous level of acrylamide, as is the case with cocoa beans which have not yet been roasted.

At page 4 of the response, applicant argues that

In contrast to the Examiner's positions, Applicants respectfully assert that those skilled in the art would understand what it [sic; is] meant by the foregoing comparison. Indeed, one skilled in the art does not need to know how much asparagine or acrylamide is present in conventionally processed beans to understand that when such beans are treated in accordance with the present invention, the amount of asparagine or acrylamide in the beans is less than it would have been had the beans been left untreated.

This is not deemed persuasive for the reasons of record. Regarding applicant's statement “that those skilled in the art would understand what it meant by the foregoing comparison”, it is unclear upon what basis applicant makes such an assertion. The examiner has set forth logical reasoning and factual analysis supporting the rejection, yet applicant simply asserts “that those skilled in the art would understand what it meant by the foregoing comparison.” This is without support and is not deemed persuasive.

Regarding applicant's statement that “one skilled in the art does not need to know how much asparagine or acrylamide is present in conventionally processed beans to understand that when such beans are treated in accordance with the present invention, the amount of asparagine or acrylamide in the beans is less than it would have been had the beans been left untreated”, this, too, is not deemed persuasive for the reasons of record. Initially, it is unclear as to how applicant may make a statement that “one skilled in the art does not need to know how much asparagine or acrylamide is present in conventionally processed beans”, when applicant's claims clearly require a comparison of the level of acrylamide in the claimed cocoa bean to that of “conventionally processed cocoa beans.” Applicant's argument directly conflicts with the claimed invention.

The second part of applicant's statement, “when such beans are treated in accordance with the present invention, the amount of asparagine or acrylamide in the beans is less than it would have been had the beans been left untreated,” is not deemed persuasive, as it does not directly apply to the claimed invention. In response to applicant's argument, it is noted that the features upon which applicant relies (i.e., “acrylamide in the beans is less than it would have been had the beans been left untreated”) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Further, there would be a clear and distinct difference between the specific untreated beans initially used in applicant's invention, and any random cocoa beans

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from any source or species, processed in any particular fashion. Still further, it is unclear as to what applicant means by “untreated”, as the claims clearly require that the cocoa beans are “conventionally processed.”

As stated previously on the record, one skilled in the art would not be apprised of how much asparagine or acrylamide is contained in “conventionally processed” cocoa beans. This varies not only from species to species of cocoa, commercial brand to brand, but also even from one roast to another within the same batch of beans. Thus, there is no standard set forth by which one skilled in the art would be able to determine this amount and therefore carry out the invention. It is noted that at the top of page 22, prior to the examples, the specification states that regarding the beans processed by an asparagine-reducing enzyme, “the control sample is prepared in exactly the same manner as the enzyme-treated sample, with the exception that [the] enzyme is not added”, and the comparison is made against this standard. Once again, the suggestion is made that *this or similar language be adopted for the claims, as well*. It provides a readily-obtainable standard to utilize when assessing and producing the claimed invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Elder et al. (Pub. No. US 2004/0058054). The reference and rejection are taken as cited in a previous Office action, as are the supporting statements made by the examiner in the Office action of October 06, 2005.

Applicant's arguments filed January 06, 2006, have been fully considered but they are not persuasive. Applicant's arguments do not differ substantially from those presented previously on the record, namely in the response of July 22, 2005. In the January '06 response, applicant adds that they do not agree with the statements and reasoning found in the Office action of October 06, 2005, yet applicant does not provide any additional substantial arguments or rebuttal over those provided in the July '05

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response. The position of the Office has been properly set forth on the record, has been clearly stated and correctly maintained in light of the teachings of the reference. Thus, the rejection is maintained for the reasons of record.

### *Conclusion*

This is an RCE continuation of applicant's earlier Application No. 10/603,278. **All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.** Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**KEITH HENDRICKS**  
**PRIMARY EXAMINER**